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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,122	02/02/2004	Chao-Jen Lin		5622

7590
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EXAMINER

HUYNH, KHOA D

ART UNIT PAPER NUMBER

3751

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,122

Applicant(s)

LIN, CHAO-JEN

Examiner

Khoa D. Huynh

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "242" and "263" have both been used to designate the shallow slot(s). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 3 is objected to because of the following informalities: line 2, the recitation "a round hole...of the tube cap" should be changed to read --a round hole...of each of the tube caps--. Also line 3, the recitation "positioning pin" should be changed to read --positioning pins--. Also lines 3-4, the recitation "the round hole of the upper and lower tube cap" should be changed to read -- the round holes of the upper and lower tube caps--. Also claim 3 should be changed to depend on claim 2. Appropriate correction is suggested.

3. Claim 4 is objected to because of the following informalities: claim 4 should be changed to depend on claim 3. Appropriate correction is suggested.

4. Claim 9 is objected to because of the following informalities: claim 9 should be changed to depend on claim 8. Appropriate correction is suggested.

Claim 21 is objected to because of the following informalities: claim 21 should be changed to depend on claim 20. Appropriate correction is suggested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite as to whether applicant intends to claim the subcombination of a paper dispenser or the combination of a paper dispenser and a conventional paper roll. The preamble of claim 1 only calls for a paper dispenser. However, throughout the body of the claim, elements of the paper dispenser are inferentially connected to a conventional paper roll. For example, lines 4-5 of claim 1 calls for a paper dispenser having a rear end; however, in line 5, the rear end is defined as "connected to an initial end" of a conventional paper roll which is the intended environment. Should applicant intend to claim to cover only the subcombination, the examiner suggests language such "adapted to be" when referring to structural connection of the subcombination to its environment. Should applicant, on the other

Art Unit: 3751

hand, intend the claim to cover the combination, the examiner suggests amending to preamble such as "A paper dispenser in combination with a conventional paper roll..." or "A pen with a paper dispenser in combination with a conventional paper roll..."

7. Claim 3 recites the limitation "the tube cap" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 4 recites the limitation "the upper positioning pin" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 9 recites the limitation "the annular spring" in line 1. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 21 recites the limitation "the annular spring" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5, 7-17, and 19-22, as presently and best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (4812069).

Regarding claim 1, the White et al. reference discloses a writing implement having built-in paper dispenser. The paper dispenser includes a tube (26) having an elongated lateral opening (29) and a cavity (about 38). The paper dispenser also includes a central shaft (at 70, 92) disposed inside the cavity of

the tube, a spring set for shaft (91,96) having a leading end (about 90) inserted and fixed on the central shaft and a rear end connected to the initial end (the end opposite end 99) of the paper roll (at 81). The paper dispenser also includes an annular leafspring set (17, 78,79,80) arranged between the tube and the spring set for shaft.

Regarding claim 2, the tube has two tube caps (at 41 & 25 as schematically shown in Figure 10) covering the top and bottom thereof.

Regarding claim 3, as schematically shown in Fig. 10, the tube cap (at 41) includes a round hole (at 57). An upper and lower positioning pins (at 68 & 42) are inserted and positioned through the round hole of the cap.

Regarding claim 4, a ratchet wheel (at 102) is installed on the upper positioning pin (about 42).

Regarding claim 5, as schematically shown in Fig. 6, the paper dispenser also includes an arcuate elastic piece (80) having one end connected to the elongated lateral opening (at 29) and the other end rests against the outer layer of the paper roll.

Regarding claim 7, the annular leafspring set is an open ring spring (80) made of curled elastic piece.

Regarding claim 8, as schematically shown in Fig. 6, the annular leafspring set has an annular spring (at 80).

Regarding claim 9, as schematically shown in Fig. 6, the annular spring is arranged inside the tube to restrain the circumference of the paper roll.

Regarding claim 10, it is inherent that the contact area between the paper roll and the annular leafspring set (Fig. 6) is under a certain value.

Regarding claim 11, the White et al. reference discloses a writing implement having built-in paper dispenser having all features as discussed supra. The White et al. reference also discloses that the writing implement includes a penholder with a refill (45) for writing and the paper dispenser is arranged on the top of the penholder (Fig. 4).

Claims 12 and 13 recite limitations that are similar to the recitations of claims 3 and 4 which have been rejected as discussed supra.

Regarding claim 14, a rotation cap (18) is set on the ratchet wheel and the central shaft is controlled by the rotation of the rotation cap.

Regarding claim 15, as schematically shown in Fig. 8, a shaft brake with a serrated braking part (at 103) so as to lock the ratchet wheel and restrain the central shaft.

Regarding claim 16, a shallow slot (formed by elements 104) is being lock with the shaft brake while the shaft brake blocks the rotation of the central shaft.

Claims 17 and 19-22 recite limitations that are similar to the limitations of claims 5 and 7-10 which have been rejected as discussed supra.

13. Claims 1, 2, 6, 11 and 18, as presently and best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Henson et al. (2099268).

Regarding claim 1, the Henson et al. reference discloses a writing implement having built-in paper dispenser. The paper dispenser includes a tube

(57) having an elongated lateral opening (72) and a cavity (the hollow portion that holds the paper roll 70). The paper dispenser also includes a central shaft (at 65) disposed inside the cavity of the tube, a spring set for shaft (69,73) having a leading end (at 68) inserted and fixed on the central shaft and a rear end connected to the initial end of the paper roll (at 70). The paper dispenser also includes an annular leafspring set (at 81) arranged between the tube and the spring set for shaft.

Regarding claim 2, the tube has two tube caps (at 59 & 78 as schematically shown in Figure 10) covering the top and bottom thereof.

Regarding claim 6, the spring set for shaft is a spring (at 73) in close ring shape and is made of a curled elastic piece with elasticity in radial direction.

Regarding claim 11, the Henson et al. reference discloses a writing implement having built-in paper dispenser having all features as discussed supra. The Henson et al. reference also discloses that the writing implement includes a penholder (2) with a refill for writing and the paper dispenser is arranged on the top of the penholder (Fig. 1).

Claim 18 recites limitations that are similar to the limitations of claim 6 which has been rejected as discussed supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

Art Unit: 3751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoa D. Huynh
Primary Examiner
Art Unit 3751

HK
08/17/2005